

REMARKS

Claims 13 to 35 are now pending in the present application.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With regard to paragraph three (3), claims 13 to 16 and 18 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,208,923 (the “Hommel” reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

It is respectfully submitted that the “Hommel” reference does not disclose (nor even suggest) the claim 13 feature of “at least two electrical units; and power supply units, each of the electrical units being assigned a respective one of power supply units, and each being connected via at least one fuse.” The Final Office Action concedes this critical deficiency. (Final Office Action, paragraph 3).

The “Hommel” reference concerns a “fault mode” which deals with malfunctions in the system, so that if a fault occurs “the system in which the fault has occurred is shut down.” (“Hommel”, column 3, lines 53 to 56). Accordingly, one skilled in the art would not be motivated to modify the “Hommel” reference as suggested in the Final Office Action because “Hommel” has a “fault mode” that addresses malfunctions, which makes fuses redundant at best.

Further, the Final Office Action has not provided any support for the proposition that there was a reasonable expectation of success for the proposed modification of the “Hommel” reference. In this regard, by disabling power (via fusing its power supply) to the electronic components of the “Hommel” system (as suggested by the Final Office Action), it may prevent the “fault mode” from shutting down the defective components.

Indeed, it is respectfully submitted that one skilled in the art would not have any motivation to modify the “Hommel” reference as suggested by the Final Office Action because it may even defeat the purpose and intent of the “fault mode.” *A prima facie* obviousness cannot be established based on a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, since there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

As further regards the obvious rejection, the “Hommel” reference does not disclose (nor suggest) the claim 13 feature of “at least two electrical units operate independently of one another.” With the process computer of the “Hommel” reference, “[i]n the event of a fault, the process computer of one system shuts down the other system via no-current-opening relays.” (“Hommel”, column 1, lines 64 to 67 (emphasis added)). Thus, there is reciprocal influencing of the two systems. For example, a fault within one system can have an effect on the other system, and thus can affect the functioning of the entire steering system. Therefore, the electrical units don’t operate independently of one another as provided for in the context of the claimed subject.

For at least the foregoing reasons, claim 13, and its dependent claims 14 to 16 and 18 are allowable. It is therefore respectfully requested that the obviousness rejections be withdrawn.

With regard to paragraph four (4), claims 13, 17, 19, 20, and 22 to 24 were rejected under 35 U.S.C. 103(a) as unpatentable over the combination of the “Hommel” reference in view of U.S. Patent No. 6,904,346 (the “Higashi” reference).

Claim 13 is allowable for essentially the same reasons as provided in the context of the obviousness discussion of the “Hommel” reference because the secondary “Higashi” reference does not cure -- and is not asserted to cure -- the critical deficiency of the primary “Hommel” reference. It is therefore respectfully requested that the obviousness rejection for claim 13 and its respective dependent claims be withdrawn.

Claim 19 includes features like those of claim 13 and, is therefore allowable for essentially the same reasons as claim 13 since the secondary “Higashi” reference does not cure -- and is not asserted to cure -- the critical deficiency of the primary “Hommel” reference. It is therefore respectfully requested that the obviousness rejection for claim 19 and its dependent claims 19, 20, and 22 to 24 be withdrawn.

With regard to paragraph five (5), claims 13 to 20 and 22 to 35 were rejected under 35 U.S.C. § 103 as being unpatentable over German Patent No. DE 101 14 600 (the “Rieth” reference, in view of U.S. Application No. 2002/0166716 (the “Shimizu” reference).

It is respectfully submitted that the “Rieth” reference does not disclose (nor suggest) the claim 13 feature in which the “at least two electrical units operate independently of one another.” In this regard, the Final Office Action has not even addressed this claim feature. In fact, the Final Office Action has not identified any section of the references (including the Rieth reference) that even discusses the feature in which at least two electrical units operate independently of one another, as provided for in the context of the claimed subject matter. As to the secondary “Shimizu” reference, it does not cure -- and is not asserted to cure -- this critical deficiency.

For at least this reason, claim 13, and its dependent claims 14 to 18 are allowable over the combination of the “Rieth” and “Shimizu” references. It is therefore respectfully requested that the obviousness rejections be withdrawn.

Claim 19 includes the features in which “the first torque control element is a manual-torque control element for a steering handle, and the second torque control element is a wheel-torque control element for at least one steered vehicle.” The “Hommel” reference does not disclose (nor suggest) all of these features. In fact, the Final Office Action concedes that “Hommel mentioned above fails to disclose a manual torque element for a steering

handle.” (Final Office Action, page 3, paragraph 4). As to the “Higashi” reference, it simply does not cure this critical defect since there is no proper support for the assertions of the Final Office Action.

It is respectfully submitted that the cases of In re Fine, *supra*, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

It is believed and respectfully submitted that the present Final Office Action offers no evidence, but only conclusory hindsight, reconstruction and speculation, which these cases

have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

The Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference, whether taken alone or combined, makes plain that it simply does not describe the features discussed above of the rejected claims.

It is therefore respectfully requested that the obviousness rejection for claim 19 and its dependent claims 19, 20, and 22 to 24 be withdrawn.

With regard to paragraph six (6), claim 21 was rejected under 35 U.S.C. § 103 as being unpatentable over the “Hommel reference in view of the “Higashi” reference, in further view of U.S. Patent Application no. 2005/0082108 (the “Husain” reference).

Claim 21 depends from claim 19 and is therefore allowable for the same reasons as claim 19 since the "Husain" reference does not cure -- and is not asserted to cure -- the critical deficiencies of the "Hommel" and "Higashi" references. It is therefore respectfully requested that the obviousness rejection for claim 21 be withdrawn.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 13 to 35 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that claims 13 to 35 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

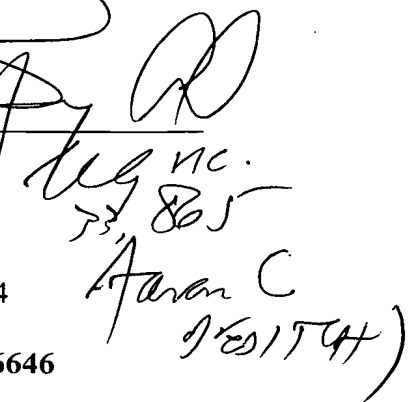
Respectfully submitted,
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Dated: 4/27/2009

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